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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/685,554

10/16/2003

Brandl Raymond

BRANDL-1

4934

32132

7590

10/23/2006

LAMORTE & ASSOCIATES P.C.

P.O. BOX 434

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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/685,554

Applicant(s)

RAYMOND, BRANDL

Examiner

Matthew Heneghan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/16/03</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-12 have been examined.

#### ***Priority***

2. The instant application claims priority to U.S. Provisional Patent Application No. 60/427,834, filed 20 November 2002.

#### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the first and last names of the inventor appear to have been reversed in the inventor's name.

#### ***Information Disclosure Statement***

4. The following Information Disclosure Statement in the instant application has been fully considered:

IDS filed 16 October 2003.

5. The IDS filed on 16 October 2003, which accompanied the filing of the instant application, includes a statement that was not signed. Since the IDS was clearly filed by the Applicant and is in compliance with 37 CFR 1.97 and 37 CFR 1.98, it has nonetheless been considered, though the accompanying statement has not.

### ***Claim Objections***

6. Claim 11 is objected to because of the following informalities: The preamble ends with a semi-colon, rather than a colon.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 11 recites that the computer is automatically connected to a network by sending a transmission and later automatically disconnected from the network once responding request data is received from the computer network (see claim 11, lines 12-16). Applicant's specification suggests that this is performed by employing a protocol that may be used to automatically change the state of the switch control circuit upon the receipt of a completion signal. Though Applicant's specification discloses the supplying of such a protocol (see p. 14, lines 5-16), Applicant's specification neither discloses a well-known protocol that could be used for this purpose or disclose any details of a suitable protocol. Though the art is highly predictable in nature, no protocol has been found in the prior art that would be clearly applicable to the application of the instant invention.

For one of ordinary skill in the art, the developing or discovery of a protocol that would actuate the switch control circuit for this purpose in light of Applicant's specification would require undue experimentation.

Claim 12 depends from rejected claim 11, and include all the limitations of that claim, thereby rendering that dependent claim as lacking enablement.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,202,153 to Diamant.

As per claims 1-5, Diamant discloses switches between a computer and two networks, one public and one secure, wherein no more than one switch is closed (i.e. enabling network connectivity) at any given time. Diamant discloses a scenario wherein, at bootup, the switch to the secure network is open and the switch to the public network is closed. An operating system is downloaded from the public network (a transfer which is inherently initiated by a signal from the computer); upon a user command, the system then switches to secure mode, opening the public switch (see column 20, line 54 to column 22, line 10).

Regarding claim 6, since the system is able to open and close each switch, an operational protocol for doing so must exist.

As per claim 7, Diamant discloses that a visual indicator may be used to show the current mode (i.e. switch position) of the device (see column 20, lines 33-40).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,202,153 to Diamant in view of U.S. Patent No. 5,202,997 to Arato.

As per claim 8, Diamant discloses a network connection switch having a switch assembly connected to a first port and a second port (662), a first port for connecting a switch assembly to a network (656), a second port connecting the switch to the computer (connection to the bus, 664). See column 14, lines 64 to column 15, line 7 and figure 10.

Diamant does not disclose how the signal is sent to the switch that actuates it.

Arato discloses a peripheral access control wherein a latch governing peripheral access is controlled by trigger circuitry and suggests that this gives an access control means that is usable with personal computers (see column 1, lines 52-59 and column 4, line 55 to column 5, line 6).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the invention of Diamant by using a latch controlled by trigger circuitry to govern access, as disclosed by Arato, as that this gives an access control means that is usable with personal computers.

As per claim 9, Diamant discloses that a visual indicator may be used to show the current mode (i.e. switch position) of the device (see column 20, lines 33-40).

As per claim 10, a third port, Diamant discloses that a third port, to the storage unit I/O (670) is also connected to the bus; Arato's trigger circuitry would likewise be connected to such a port.

***Allowable Subject Matter***

10. Claims 11 and 12 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

11. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 11, though Diamant discloses most of the limitations, as discussed above, no prior art found suggested a mechanism by which a network connection switch could be actuated automatically based upon a received data flow that responds to a sent request rather than by outside intervention, such as from the user. It is noted that Applicant has not disclosed a protocol by which this automatic functionality is accomplished, as discussed above.

Regarding claim 12, Diamant discloses the use of a modem (see column 3, line 34); however, the claim would be allowable based upon its dependence on claim 11.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, can be reached at (571) 272-3799.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

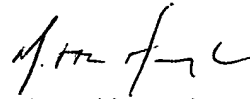
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MEH

October 19, 2006

A handwritten signature in black ink, appearing to read 'M. Heneghan'.

Matthew Heneghan, USPTO Art Unit 2134